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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,637	10/23/2002	Alexander Sher	112843-028	8331
29157	7590	04/25/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			PRATT, HELEN F	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,637

Applicant(s)

SHER ET AL.

Examiner

Helen F. Pratt

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 8, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash et al. (WO 98/21953).

Nash et al. disclose a liquid nutritional supplement as in claims 3 and 14, which is made by dissolving a casein source in water and by dissolving a mineral mixture in water, both forming slurries which are mixed together and then the pH is adjusted to from 6.9 to 7.0 except that the solutions are not adjusted to the claimed pH before they are combined (page 10, lines 24-35 and page 11, lines 10-11, 32-33). The ferric state must have been maintained because the iron does not cause discoloration of the liquid supplement during thermal processing (page 11, lines 24). Nothing is seen at this time that the pH's of the two solutions were not within the claimed level since the ferric state is maintained. Claim 3 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796.

Claims 3 and 14 further require the use of ferric sulfate instead of the ferric orthophosphate of the reference to Nash. However, the claims except for claims 14-19 are product by process claims in which the method of making the product is not given weight absent objective evidence that their process makes for a different product. Nothing is seen in applicants' specification that shows that the products are different. In addition, the process of Nash would have made the same product as claimed absent a showing to the contrary. In the product by process claims, the product is a ferric-caseinate complex. As to process claim 14, nothing has been shown that using a different ferric salt as shown by Nash, makes for a patentably different product. In applicants' specification many different types of ferric compounds are claimed, therefore, nothing is seen that the claimed ferric compound makes for a different product. Therefore, it would have been obvious to make a ferric-caseinate complex since the claimed product has been shown.

Claim 4 further requires fat. The reference discloses the addition of safflower oil to the composition (page 12, lines 33-37). Therefore, it would have been obvious to add oil to a ferric caseinate complex as disclosed by Nash et al.

Claim 8 further requires that the liquid beverage containing ferric-caseinate and lipids be retorted. Nash et al. discloses that their beverage is sterilized which is what retorting does (page 17, lines 27-32 and page 18, lines 1-4, page 8, lines 4-19). The particular process is not given weight in a composition claim. Therefore, it would have been obvious to heat sterilize a liquid beverage composition as claimed.

The limitations of claims 1, 15-17, 19-21, 23-25 have been discussed above and are obvious for those reasons.

Claims 5-7, 9, 10, 13, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above reference (Nash) as applied to the above claims and further in view of Dolan et al. (H1620) and Myers et al.

Claims 5 and 22 further requires the addition of polyphenols. Nash et al. disclose that flavorings can be added to the composition (page 17, lines 9-10). Chocolate is another known flavorant for beverages, which are milk- like. Dolan et al. disclose that it is known to make a chocolate flavored beverage mix containing iron (col. 10, lines 55-60). Chocolate is known to contain polyphenols as disclosed by Myers et al. (col. 1, lines 20-70). Therefore, it would have been obvious to use a flavorant such as chocolate, which contains polyphenols in the claimed process of Nash et al.

Dolan et al. disclose a chocolate beverage base (mix) as in claims 6 and 13 (abstract) and beverages are disclosed as in claim 7 (col. 8, lines 55-60). Therefore, it would have been obvious to use the composition of the combined references to make as chocolate base or drink.

Claim 9 further requires that the beverage is chocolate and claim 10 requires a retorted liquid with polyphenols. The claimed limitations have been shown above and are obvious for those reasons.

Claim 11 further requires that the beverage is a tea beverage. As above, Nash discloses that his composition can contain various flavorings. Tea is a flavoring. Therefore, it would have been obvious to add tea to the composition of Nash et al. to add flavoring.

Claims 2, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan et al. in view of (WO 98/42745) Sakurai et al. and Hidalgo et al. (4,303,580).

Claims 2 and 12 further require that the composition is a beverage powder. In re Thorpe, supra applies to all the instant compositions. Dolan et al. disclose a dried beverage powder (abstract). Claim 12 differs from the reference in the use of a ferric-caseinate complex made by a particular method. Sakurai et al. disclose an iron casein complex which is a ferric caseinate complex made by a different method (abstract) and col. 8, lines 20-40). Hidalgo et al. disclose a caseinate in powder form, which contains ferric iron (col. 1, 20-34, lines 60-70 and col. 2, lines 1-4, col. 3, lines 18-24). The iron caseinates can be used in infant and dietetic products (abstract). Therefore, it would have been obvious to use the ferric caseinates of Sakurai et al. and Hidalgo et al. in place of the iron in Dolan et al. 's cocoa product due to their more desirable palatability (Sakurai et al. col. 1, lines 20-65).

ARGUMENTS

Applicant's arguments filed 9-2-04 have been fully considered but they are not persuasive.

Applicants argue that the reference to Nash teaches away from the use of ferric sulfate because it causes the liquid supplement to turn grey during thermal processing. However, not all of the claims require that the beverage is retorted or uses thermal processing. In addition, most of the claims except for claim 14 are product by process claims and nothing has been shown that a different product has been made using the process of Nash, or that the product of Nash is different than the claimed product. As to the process of claim 14, nothing has been shown that ferric ortho phosphate produces a different product than the other ferric compounds disclosed in the specification as being interchangeable with ferric sulfate (page 4).


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Applicants argue as to the secondary references that they also do not disclose the use of ferric sulfate. However, they are used for what they teach as above. Even if Hidalgo et al. disclose the use of ferrous sulfate instead of ferric, a caseinate is still made, and no patentable distinction is seen between the ferric caseinate and ferrous caseinate absent a showing that a different product is made. As to Sakuri, an iron caseinate has still been made, and the other ingredients in the composition have not been excluded from the composition. Ferric sulfate as claimed is disclosed in col. 8, lines 35-40. No showing has been made that these compositions are different than the claimed compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). 4-19-05 hp


HELEN PRATT
PRIMARY EXAMINER